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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/604,135	06/27/2003	Reinhard Lihl	LVIP106US	1134
24041	7590	12/16/2004	EXAMINER	
SIMPSON & SIMPSON, PLLC 5555 MAIN STREET WILLIAMSVILLE, NY 14221-5406			BLAKE, CAROLYN T	
			ART UNIT	PAPER NUMBER
			3724	

DATE MAILED: 12/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/604,135

Applicant(s)

LIHL ET AL.

Examiner

Carolyn T Blake

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) 5-9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on 27 June 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Species II in the reply filed on November 30, 2004 is acknowledged. With respect to Applicant's assertion that claim 1 is generic, this is incorrect. A generic claim must comprehend within its confines the organization covered in each of the species. See MPEP 806.04(d). With respect to claim 1, the claim is not including the additional organization of Species III and IV, such as the frosted glass disk and water of Species III in claim 7 and the power source (battery) of Species IV in claim 9.

Nevertheless, if a claim, such as claim 1, is broad enough to encompass all the species is deemed allowable and there is compliance with 35 USC 112, paragraph 2, with respect to the dependent claims to the other species, rejoinder will be permitted.

The requirement is still deemed proper and is therefore made FINAL.

2. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Drawings

3. Figure 2 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid

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abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.121(d)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

4. The disclosure is objected to because an incomplete sentence exists in paragraph 24, lines 20-21 (beginning with, "The heat emission"). Appropriate correction is required.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over German Patent DE 32 24 375 to Bilek in view of German Patent DE 36 15 713 to Wolf and US Patent Application 2003/0024368 A1 to Fukuoka. Bilek discloses a microtome (FIGS 1-3) having a knife (3), a specimen arm (1) movable relative to the knife (3), and at least one light source (6) acting as a base-mounted illumination system, at least one light source (6) acting as an incident illumination system for and at least one light source (6) acting as an internal preparation illumination system, wherein all illumination systems illuminate a region around the preparation. Bilek fails to disclose the light source is a

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light-emitting diode. Wolf discloses a microtome (FIGS 1 and 2) having a specimen arm (18) and an illumination system with a light source in which the light source is a light-emitting diode (89). Furthermore, Fukuoka discloses an illumination system for a cutting device in which incandescent lamps, fluorescent lamps, or light-emitting diodes can be interchanged. Fukuoka states it is preferable to use LEDs because they generate relatively no heat in comparison to the incandescent lamps or fluorescent lamps (paragraph 55). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a light-emitting diode, as disclosed by Wolf, on the Bilek device in order to reduce heat generation, as disclosed by Fukuoka.

7. Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bilek in view of Wolf and Fukuoka as applied to claim 1 above, and further in view of Shankle et al (6,195,016 B1).

Regarding claim 2, Bilek in view of Wolf and Fukuoka discloses the base-mounted illumination system encompasses at least one light-emitting diode, but fails to disclose a frosted glass disk mounted in front of the light-emitting diode. Shankle et al disclose the use of a frosted glass disk in combination with LEDs for the purpose of providing uniform white illumination light (col. 7, lines 1-7). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a frosted glass disk, as disclosed by Shankle et al, on the Bilek in view of Wolf and Fukuoka device for the purpose of providing uniform white illumination light.

Regarding claim 3, Bilek discloses the light source (6) is mounted on the microtome in such a way that a light beam (8) proceeding from the base-mounted illumination system is reflected by a backside (15) of the knife (3) and at the preparation so as thereby to achieve uniform illumination of the gap between the knife (3) and preparation. See FIG 3.

8. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bilek in view of Wolf, Fukuoka, and Shankle et al as applied to claims 2 and 3 above, and further in view of Douglas-Hamilton et al (4,896,967). Bilek discloses the light source (6) coincides with an optical axis (5) of an observation microscope (4). Bilek in view of Wolf, Fukuoka, and Shankle et al fails to disclose the base-mounted illumination system has a first and second light-emitting diode which are inclined with respect to one another at an angle. Douglas-Hamilton et al disclose a base-mounted illumination system (FIG 8) with a first and second light-emitting diode (134) that are inclined with respect to one another at an angle (142). This configuration enhances the uniformity of illumination while preventing direct radiation from entering the observation microscope (col. 7, lines 19-26). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a first and second light-emitting diode that are inclined with respect to one another at an angle, as disclosed by Douglas-Hamilton et al, on the Bilek in view of Wolf, Fukuoka, and Shankle et al device for the purpose of providing uniform illumination while reducing direct radiation.

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Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Ikado et al (6,313,943 B1) disclose a first and second light-emitting diode which are inclined with respect to one another at an angle (FIG 6b).

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carolyn T Blake whose telephone number is (571) 272-4503. The examiner can normally be reached on Monday to Friday, 8:00 AM to 5:30 PM, alternating Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan N Shoap can be reached on (571) 272-4514. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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December 10, 2004


Allan N. Shoap
Supervisory Patent Examiner
Group 3700